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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/747,020

12/26/2000

Koichi Awano

001740

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04/19/2006

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP  
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WASHINGTON, DC 20006

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/747,020	AWANO, KOICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 2, and 4 are pending and claim 4 has been amended in this communication filed 1/23/06 entered as Response After Non-Final Action and Request for Extension of time.
2. The 35 USC 112 second paragraph rejection has been overcome by Applicant's amendment to the claim and is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over (6,473,500 B1) Risafi et al, hereafter Risafi in view of (US 6,003,762) Hayashida.

As per claim 1, Risafi teaches, A card settlement system using a debit card comprising: means for using a debit card having a money withdrawal function to issue a prepaid card (col. 3, line 53-col. 4, line 47); means for transmitting settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued (col. 13, lines 53-62). Risafi failed to teach, means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data. Hayashida teaches, means for remitting from said settlement

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bank to a store's account in said store's bank on the basis of said settlement data (col. 5, lines 51-61, col. 8, line 56- col. 9, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data and to modify in Risafi because such a modification would allow Risafi to have an ATM terminal unit that writes the information about the amount the owner transfers between his bank deposit account and the multi-function IC card and to consummate the processing of the settlement data.

As per claim 2, Risafi teaches, The card settlement system according to Claim 1, wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount (col. 13, lines 19-62).

As per claim 4, Risafi teaches, A card settlement system using a debit card including an ATM of a settlement bank, said ATM comprising: means for using a debit card having a money withdrawal function to issue a prepaid card (col. 3, line 53-col. 4, line 47); means for inserting a prepaid card having a balance into said ATM (col. 13, line 63-col. 14, line 19); means for inputting an identification number (col. 14, lines 37-55). Risafi failed to teach, means for permitting withdrawal of money when said identification number is proper and for processing said prepaid card to an invalid state. Hayashida teaches means for permitting withdrawal of money when said identification number is proper and for processing said prepaid card to an invalid state (col. 12, lines 27-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for permitting withdrawal of money when said identification

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number is proper and for processing said prepaid card to an invalid state and to modify in Risafi because such a modification would allow Risafi to have the capability to perform a validity check on the card to permit the execution of normal processing.

### ***Response to Arguments***

5. Applicant's arguments filed 1/23/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Risafi et al discloses only the purchase of a prepaid card, but does not disclose using a debit card to issue a prepaid card and there is no mention of a debit card in the passage cited by the Examiner has been considered but is not persuasive. Response: Risafi discloses in Figure's 4, 5b, 6a, 6b, 7a, 7b, 8 a, and 8b and col. 1, lines 37-53 a "prepaid debit card center" and an "issuer". Therefore, it is interpreted that Risafi does disclose a debit card which can be used to issue a prepaid card.

Conclusion: The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Risafi and Hayashida, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

*During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once*

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*issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). <*

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Inquiries**


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 13, 2006

  
ELLA COLBERT  
PRIMARY EXAMINER